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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,716	07/18/2000	Kyoji Saito	P19789	9554

7055 7590 05/20/2004		EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C.		PHAN, TAM T	
1950 ROLAND CLARKE PLACE			
RESTON, VA 20191	ART UNIT	PAPER NUMBER	
	2144		

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/618,716	SAITO, KYOJI
	Examiner	Art Unit
	Tam (Jenny) Phan	2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _13 February 2004_.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _13-36_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _13-36_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _18 July 2000_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This application has been examined. Amendment A received on 02/13/2004 has

been entered. Claims 1-12 are cancelled. Claims 13-36 are new. Claims 13-36 are

presented for examination.

Priority

2.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-d, which

papers have been placed of record in the file.

3.   The effective filing date for the subject matter defined in the pending claims in

this application is 11/11/1999.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 13-15 and 20-22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Ishibashi et al. (U.S. Patent Number 6,374,291), hereinafter referred to

as Ishibashi in view of RFC2305 (RFC2305 – "A Simple Mode of Facsimile Using

Internet MAIL" March 1998– Referred to PTO 892 for details).

6.   Regarding claim 13, Ishibashi disclosed an image receiving apparatus comprising:

a receiver configured to receive an e-mail with data attached, via a computer network and

a controller configured to convert the attached data into image data (Abstract, column 4

lines 24-34, lines 44-67, column 5 lines 1-7).

7.   Ishibashi taught the invention substantially as claimed. However, Ishibashi did not

expressly teach the controller further being configured to judge whether or not the

received e-mail is an error mail [unwanted mail], based on whether or not a header of the

e-mail includes a predetermined character string, the predetermined character string being

related to a sender of the error mail.

8.   Ishibashi suggested exploration of art and/or provided a reason to modify the

image apparatus with the judging unwanted email feature (Figure 3(b), Figure 4, column

6 lines 34-44).

9.   RFC 2305 disclosed teachings of judging whether or not the received e-mail is an

unwanted mail, based on whether or not a header of the e-mail includes a predetermined

character string, the predetermined character string being related to a sender of the error

mail (Sections 2.2.1, 5.1, 5.2.1, 5.2.2).

10.   It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to modify the image receiving apparatus of Ishibashi with the

teachings of RFC2305 to include the judging unwanted mail feature in order to maintain

interoperability with Internet mail (Section 5.1) since any security to be provided should

be part of the Internet security infrastructure (Section 5.1). In addition, judging unwanted

mail feature would also help save resources since unwanted bulk mails consume

resources and therefore undesirable (Section 5.2.2 paragraphs 1-2).

11.   Regarding claim 14, the Ishibashi and RFC2305 disclosed an image receiving

apparatus further comprising a printer configured to print the image data, wherein the

controller, when an error mail is detected, abstracts predetermined information from the

e-mail, and converts the abstracted predetermined information into image data, and the

printer prints the converted image data (Ishibashi, Abstract, Figures 11, 12, column 8

lines 34-57; RFC2305, Sections 2.3.2, 5.2.4).

12.   Regarding claim 15, the Ishibashi and RFC2305 disclosed an image receiving

apparatus further comprising a printer configured to print image data, wherein the

controller, when an error mail is detected, abstracts predetermined information from the

e-mail, edits the abstracted predetermined information, and converts the edited

information into image data, and the printer prints the converted image data (Ishibashi,

Abstract, Figures 11, 12, column 8 lines 34-57; RFC2305, Sections 2.3.2, 5.2.4).

13.   Regarding claim 20-22, the method corresponds directly to the image receiving

apparatus of claims 13-15, and thus these claims are rejected using the same rationale.

14.   Since all the limitations of the claimed invention were disclosed by the

combination of Ishibashi and RFC2305, claims 13-15 and 20-22 are rejected.

15.   Claims 16-19 and 23-26 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Ishibashi et al. (U.S. Patent Number 6,374,291), hereinafter referred to

as Ishibashi in view of RFC2305 (RFC2305 – "A Simple Mode of Facsimile Using

Internet MAIL" March 1998– Referred to PTO 892 for details) and further in view of

Chen et al. (U.S. Patent Number 5,832,208), hereinafter referred to as Chen.

16.   Regarding claim 13, Ishibashi disclosed an image receiving apparatus receiving

an e-mail, the e-mail including a header and a body, the body including a message, the

message including an image data part, the image receiving apparatus comprising: a

receiver configured to receive an e-mail with data attached, via a computer network; and

a controller configured to convert the attached data to image data (Abstract, column 4

lines 24-34, lines 44-67, column 5 lines 1-7).

17.   Ishibashi taught the invention substantially as claimed. However, Ishibashi did not

expressly teach the controller further being configured to judge whether or not the

received e-mail is an error mail [unwanted mail].

18.   Ishibashi suggested exploration of art and/or provided a reason to modify the

image apparatus with the judging unwanted email feature (Figure 3(b), Figure 4, column

6 lines 34-44).

19.   RFC 2305 disclosed teachings of judging whether or not the received e-mail is an

unwanted mail when the received e-mail is a multi-part structure (Sections 2.2.1, 5.1,

5.2.1, 5.2.2, 5.2.4).

20.   It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to modify the image receiving apparatus of Ishibashi with the

teachings of RFC2305 to include the judging unwanted mail feature in order to maintain

interoperability with Internet mail (Section 5.1) since any security to be provided should

be part of the Internet security infrastructure (Section 5.1). In addition, judging unwanted

mail feature would also help save resources since unwanted bulk mails consume

resources and therefore undesirable (Section 5.2.2 paragraphs 1-2).

21.   The combination of Ishibashi and RFC2305 taught the invention substantially as

claimed. However, the combination of Ishibashi and RFC2305 did not expressly teach

searching for a predetermined image data fixed code [signature code] in the image data

part of the e-mail [body of the email] and to judge that the received e-mail is an error

mail [unwanted mail] when the predetermined image data fixed code [signature code] is

detected.

22.   RFC2305 suggested exploration of art and/or provided a reason to modify the

image receiving apparatus of Ishibashi and RFC2305 with the searching of signature code

in a multi-part mail structure (Section2 2.2.4, 5.2.4).

23.   Chen disclosed a controller [agent] for searching a predetermined image data

fixed code [signature code] in the image data part of the e-mail when the received e-mail

is a multi-part structure, and to judge that the received e-mail is an error mail when the

predetermined image data fixed code [signature code] is detected (column 1 lines 49-56,

column 2 lines 18-34, lines 47-52,column 3 lines 16-32).

24.   It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to modify the combined apparatus of Ishibashi and RFC2305 with

the teachings of Chen to include the searching of signature code in a multi-part mail

structure in order to provide a more efficient method of identify unwanted mail since

Email From addresses are trivial to fake, so that using on the MAIL FROM or From

header is not sufficient (RFC2305, Section 5.2.4).

25.   Regarding claim 17, the RFC2305 and Chen combined disclose an image

receiving apparatus wherein the controller searches for the predetermined image data

fixed code in the whole received e-mail when the received e-mail is a single-part

structure, and judges that the received e-mail is an error mail when the predetermined

image data fixed code is detected (RFC2305, Sections 2.2.4, 5.2.1; Abstract, Figure 3,

column 2 lines 18-34, lines 47-52, lines 17-47).

26.   Regarding claim 18, the Ishibashi and RFC2305 disclosed an image receiving apparatus further comprising a printer configured to print image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, and converts the abstracted predetermined information into image data, and the printer prints the converted image data (Ishibashi, Abstract, Figures 11, 12, column 8 lines 34-57; RFC2305, Sections 2.3.2, 5.2.4).

27.   Regarding claim 19, the Ishibashi and RFC2305 disclosed image receiving apparatus further comprising a printer configured to print image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, edits the abstracted predetermined information, and converts the edited information into image data, and the printer prints the converted predetermined image data (Ishibashi, Abstract, Figures 11, 12, column 8 lines 34-57; RFC2305, Sections 2.3.2, 5.2.4).

28.   Regarding claim 23-26, the method corresponds directly to the image receiving apparatus of claims 16-19, and thus these claims are rejected using the same rationale.

29.   Regarding claim 27, the combination of Ishibashi, RFC2305, and Chen disclosed an image receiving apparatus connected to a server and receiving an e-mail, when the received e-mail is an error mail, the e-mail including a header and a body, the body including a message, the message including an image data part, the image receiving apparatus comprising: a receiver configured to receive an e-mail to which data is attached, via the server; a converter configured to convert the attached data into image data (Ishibashi, Abstract, column 4 lines 24-34, lines 44-67, column 5 lines 1-7); a memory [database table] configured to store a predetermined image data fixed code, an

image data fixed code being contained in the image data part (RFC2305, Section 5.2.2) ;

and a controller configured to search for a predetermined header fixed message in the

header of the received e-mail, to search for an image data fixed code in the image data

part of the message of the body of the received e-mail when the predetermined header

fixed message is not in the header of -the received e-mail, and to judge that the received

email is an error mail when the image data fixed code in the received e-mail matches the

predetermined image data fixed code stored in the memory (RFC2305, Sections 2.2.1,

5.1, 5.2.1, 5.2.2, 5.2.4; Chen, column 1 lines 49-56, column 2 lines 18-34, lines 47-

52,column 3 lines 16-32).

30.   Regarding claim 32, the method corresponds directly to the image receiving

apparatus of claims 27, and thus is rejected using the same rationale.

31.   Since all the limitations of the claimed invention were disclosed by the

combination of Ishibashi, RFC2305, and Chen, claims 16-19, 23-26, 27, and 32 are

rejected.

32.   Claims 27, 30, 32, and 35 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Wing (U.S. Patent Number 6,650,440), in view of Paul (WO

99/33188).

33.   Regarding claim 27, Wing disclosed an image receiving apparatus connected to a

server and receiving an e-mail, when the received e-mail is an error mail, the e-mail

including a header and a body, the body including a message, the message including an

image data part, the image receiving apparatus comprising: a receiver configured to

receive an e-mail to which data is attached, via the server and a converter configured to

convert the attached data into image data (Figure 2, Figure 3, column 1 lines 31-42,

column 2 lines 16-29).

34.   Wing taught the invention substantially as claimed. However, Wing did not

expressly teach a memory configured to store a predetermined image data fixed code, an

image data fixed code being contained in the image data part; and a controller configured

to search for a predetermined header fixed message in the header of the received e-mail,

to search for an image data fixed code in the image data part of the message of the body

of the received e-mail when the predetermined header fixed message is not in the header

of -the received e-mail, and to judge that the received email is an error mail when the

image data fixed code in the received e-mail matches the predetermined image data fixed

code stored in the memory [filtering unwanted mail].

35.   Wing suggested exploration of art and/or provided a reason to modify the image

receiving apparatus with the filtering unwanted mail feature (Abstract).

36.   Paul disclosed a memory [inclusion/exclusion lists] configured to store a

predetermined image data fixed code, an image data fixed code being contained in the

image data part; and a controller configured to search for a predetermined header fixed

message in the header of the received e-mail, to search for an image data fixed code in

the image data part of the message of the body of the received e-mail when the

predetermined header fixed message is not in the header of the received e-mail (page 7

lines 9-16, page 8 lines 14-27, page 9 lines 15-24, page 12 lines 21-28) and to judge that

the received email is an error mail when the image data fixed code in the received e-mail

matches the predetermined image data fixed code stored in the memory [filtering

unwanted mail] (Abstract, page 7 lines 9-16, lines 26-31, page 8 lines 23-27).

37.   It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to modify the image receiving apparatus of Wing with the teachings

of Paul to include the filter unwanted mail feature in order to control delivery of

unwanted facsimile e-mail since users might not be eager to receive unwanted mail (page

1 lines 22-23) and unwanted mail might also reduce users' productivity at the workplace

(page 1 lines 26-28).

38.   Regarding claim 32, the method corresponds directly to the image receiving

apparatus of claim 27, and thus is rejected using the same rationale.

39.   Regarding claim 30, the limitations of claim 30 are similar to the limitations of

claim 27, and thus the claim is rejected using the same rationale.

40.   Regarding claim 35, the method corresponds directly to the image receiving

apparatus of claims 30, and thus is rejected using the same rationale.

41.   Since all the limitations of the claimed invention were disclosed by the

combination of and Wing and Paul, claims 27, 30, 32, and 35 are rejected.

42.   Claims 28-29, 33-34, 31, and 36 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Wing (U.S. Patent Number 6,650,440), in view of Paul (WO

99/33188) and further in view of Iwazaki (U.S. Patent Number 6,687,742).

43.   The combination of Wing and Paul disclosed an image receiving apparatus with

all the limitations listed in claim 27 rejection above.

44.   The combination of Wing and Paul taught the invention substantially as claimed.

However, Wing and Paul did not expressly teach the predetermined header fixed message

comprises [X:mailer:] field.

45.   Paul suggested exploration of art and/or provided a reason to modify the image

receiving apparatus with the [X:mailer:] field (page 8 lines 14-27).

46.   Iwazaki disclosed a predetermined header fixed message comprises [X:mailer:]

field.

47.   It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to modify the combined apparatus of Wing and Paul to include the

[X:mailer:] in the filter unwanted feature since it would be preferable to includes all

identification data needed to determine the status of incoming mail (Paul, lines 14-18).

Most users preferred to implement filtering based upon additional list categories, such as

the "TO", "BCC", "CC", and "SUBJECT" email headers as well as other headers (Paul,

lines 21-27).

48.   Regarding claim 29, Iwazaki image receiving apparatus wherein the

predetermined image data fixed code comprises SUqk (Figure 9).

49.   Regarding claim 33-34, the method corresponds directly to the image receiving

apparatus of claims 28-29, and thus is rejected using the same rationale.

50.   Regarding claim 31 and 36, the limitation of these claims are similar to the

limitation of claim 29, and thus these claims are rejected using the same rationale.

51.   Since all the limitations of the claimed invention were disclosed by the

combination of Wing, Paul, and Iwazaki, claims 28-29, 33-34, 31, and 36 are rejected.

Response to Arguments

52.   Applicants' arguments with respect to the pending claims have been considered

but are moot in view of the new ground(s) of rejection. Referred to above rejections for

details.

53.   As the rejection reads, Examiner asserts that the combination of these teachings

render the claimed invention obvious.

Conclusion

54.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

55.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than

SIX MONTHS from the date of this final action.

56.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Tam (Jenny) Phan whose telephone number is (703) 305-

4665. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, William Cuchlinski can be reached on 703-308-3873. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 305-

3900.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

> William Cuchlinski
> SPE
> Art Unit 2144
> 703-308-3873

tp
May 15, 2004

WILLIAM A. CUCHLINSKI, JR.
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